

4. (Thrice Amended) An improvement as claimed in claim 1, wherein the polymer layer comprises a particulate filler which has a hardness different from that of the polymer composition, and is taken from the group consisting of kaolin clay, polymer material or metal.

5. (Thrice Amended) An improvement as claimed in claim 1, wherein the polymer layer completely encloses the carrier.

6. (Thrice Amended) An improvement as claimed in claim 1, wherein the carrier is endless.

7. (Thrice Amended) An improvement as claimed in claim 1, wherein the polymer layer is embossed to produce embossed soft tissue.

8. (Thrice Amended) An improvement as claimed in claim 1, together with a transfer means which comprises the transfer belt itself, which runs round a predetermined part of the Yankee cylinder to form an extended transfer nip.

REMARKS

It is submitted that these claims, as originally presented, are patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 U.S.C. 112. Changes to these claims, as presented herein, are not made for the purpose of patentability within the meaning of 35 U.S.C. sections 101, 102, 103 or 112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicant is entitled.

Amended claims 1-8 are in this application.

Applicant respectfully submits that claims 3 and 4 have been amended so as to overcome the 112 objection thereto.

Claims 1-6 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable for obviousness over U.S. Patent No. 5,393,384 (Steiner et al.) in view of U.S. Patent No. 5,298,124 (Eklund et al.).

Amended independent claim 1 now recites in part:

“wherein the transfer of said soft tissue web from said shoe press nip to the Yankee cylinder is improved due to said transfer belt’s web-contacting surface having a pressure-sensitive resettable degree of roughness, as compared with a transfer belt with a web-contacting surface not having a pressure-sensitive resettable degree of roughness.”

(Emphasis added).

In explaining the above 103 rejection, the Examiner concedes that “Steiner is silent disclosing the claimed transfer belt properties.” (Page 4 of the present Office Action). In an attempt to overcome this deficiency of Steiner, the Examiner apparently relies upon portions of Eklund.

With regard to the combining of Steiner and Eklund in the manner proposed by the Examiner, reference is made to In re Fine, (5 USPQ 2d 1596-CAFC 1988) in which the Court states at page 1599:

[obviousness] cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combinationAnd ‘teachings of references can be combined *only* if there is some suggestion or incentive to do so’.

The Court in In re Fine went on to state at page 1600:

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

There is no suggestion in Steiner, as required by the Court in In Re Fine, to combine these references in the manner suggested by the Examiner. That is, Steiner fails to consider problems associated with transferring a paper web to a Yankee cylinder. Instead, Steiner is concerned with avoiding rewetting of a web in a press section (lines 43-46 of col. 1; and lines 23-24 of col. 2, of Steiner). Accordingly, there is nothing in Steiner that would motivate one of ordinary skill in the art to improve the transfer belt as claimed in the present application, because Steiner teaches away from this.

There is also no suggestion in Eklund to combine these references as suggested by the Examiner. Since Eklund’s belt is usable for transfer of a paper web from the press section to a dryer fabric, it would be surprising that Eklund’s belt is advantageous in transferring a web from a shoe press nip to a Yankee cylinder (lines 13-18 of page 4 of the present Application).

Consequently, Eklund would not motivate one of ordinary skill in the art to reconstruct Steiner so that Steiner uses an Eklund belt, because Eklund teaches away from this.

In further support of the above arguments, it is well settled that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicant's disclosure. *In re Dow*, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988).

Therefore, it is concluded that claim 1 and claims 2-6 and 8 dependent therefrom, are unobvious over the proposed combination of Steiner and Eklund.

Claim 7 was rejected as being unpatentable for obviousness over Steiner et al. in view of Eklund et al. as applied to claim 1 above, and in further in view of U.S. Patent No. 5,556,509 (Trokhan et al.).

Claim 7 is dependent from amended independent claim 1 and is therefore believed to be distinguishable from the proposed combination of Steiner and Eklund. The Examiner apparently does not rely on Trokhan to overcome the above-described deficiencies of the combination of Steiner and Eklund. Accordingly, it is believed that claim 7 is distinguishable over the applied combination of Steiner and Eklund.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned **"Version With Markings Showing Changes Made."**

It is to be appreciated that the foregoing comments concerning the disclosures in the cited references represent the present opinions of the Applicant's undersigned attorney and, in the event, that the Examiner disagrees with any such opinions, it is requested that the Examiner indicate where, in the reference or references, there is the bases for a contrary view.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable over the prior art, and early and favorable consideration thereof is solicited.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,
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VERSION WITH MARKINGS SHOWING CHANGES MADE

IN THE CLAIMS:

Claims 1-8 have been amended as follows.

1. (Twice Amended) In a soft tissue paper machine having an essentially impermeable transfer belt [(16)] for conducting a soft tissue web [(1)] through a shoe press nip in the press section of the paper machine, and from the shoe press nip to a Yankee cylinder [(5)] in the dryer section of the paper machine in a closed draw, which Yankee cylinder forms, together with a transfer means [(17)], a transfer nip transferring the soft tissue web from the transfer belt to the Yankee cylinder, the improvement comprising an essentially impermeable transfer belt having a carrier and an elastically compressible polymer layer on its side facing the paper web, the polymer layer having a hardness between 50 and 97 Shore A and having a web-contacting surface which has a pressure-sensitive resettable degree of roughness, the web-contacting surface having a degree of roughness in a non-compressed state of $R_z = 2-80 \mu\text{m}$, measured according to ISO 4287, Part I, and a lower degree of roughness of $R_z = 0-20 \mu\text{m}$ when the polymer layer is compressed by a linear load of 20-220 kN/m applied to the essentially impermeable transfer belt as measured in a non-extended press nip,

wherein the transfer of said soft tissue web from said shoe press nip to the Yankee cylinder is improved due to said transfer belt's web-contacting surface having a pressure-sensitive resettable degree of roughness, as compared with a transfer belt with a web-contacting surface not having a pressure-sensitive resettable degree of roughness.

2. (Twice Amended) An improvement as claimed in claim 1, [characterised in that] wherein the essentially impermeable transfer belt [(16)] has an air permeability of less than $6 \text{ m}^3/\text{m}^2/\text{min}$, measured according to the method stated in "Standard Test Method for Air Permeability of Textile Fabrics, ASTM D 737-75, American Society of Testing and Materials".

3. (Thrice Amended) An improvement as claimed in claim 1, [characterised in that] wherein the polymer layer comprises a polymer composition [such as] taken from the group consisting of acryl polymer resin, polyurethane polymer resin and polyurethane/polycarbonate polymer resin composition.

4. (Thrice Amended) An improvement as claimed in claim 1, [characterised in that] wherein the polymer layer comprises a particulate filler which has a hardness different from that of the polymer composition, [such as] and is taken from the group consisting of kaolin clay, polymer material or metal[, preferably stainless steel].

5. (Thrice Amended) An improvement as claimed in claim 1, [characterised in that] wherein the polymer layer completely encloses the carrier.

6. (Thrice Amended) An improvement as claimed in claim 1, [characterised in that] wherein the carrier is endless.

7. (Thrice Amended) An improvement as claimed in claim 1, [characterised in that] wherein the polymer layer is embossed to produce embossed soft tissue.

8. (Thrice Amended) An improvement as claimed in claim 1, together with a transfer means which [consists of] comprises the transfer belt [(16)] itself, which runs round a predetermined part of the Yankee cylinder [(5)] to form an extended transfer nip.